

Appl. No. 10/698,314
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Reply to Office Action of November 2, 2004

REMARKS

The applicant thanks the Office for its diligent review of the claimed invention. In particular the applicant thanks the Office for the November 18, 2004 telephone conversation between Examiner Melody Burch and the applicant's attorney, Andrew P. Cernota.

Election/Restriction

The Examiner has made a restriction requirement in accordance with 35 U.S.C. §121 between:

Species I: Figures 1-4, 19-26, and 28-32.

Species II: Figures 5-18 and 28-31.

Species III: Figure 27.

Figure 33 was not subject to the Office's restriction requirement. No indication of claims associated with each of the alleged species, or reasons for division among species was provided. The applicant respectfully observes that the Figures are provided for the purpose of clarity and understanding of the claimed invention, illustrating various embodiments of the claimed invention and are not intended as limitations. They form part of the disclosure for all claims, as the applicant respectfully submits should be readily evident to one of ordinary skill in the art upon review of the claims. This election, therefore, should not be understood as limiting or prejudicing the applicant's right to amend the claims to claim further limitations disclosed which do not create independent and distinct inventions or subject the Office to severe burden during examination, nor should this election be interpreted as limiting the ability of the applicant to rely on the figures of the non-elected species as support for the present unamended claims that properly are examined as part of a single application. In response to the Office's restriction requirement, the applicant therefore elects, with traverse, claims 1-31, as being drawn to species II. As no claims are not elected, the applicant does not withdraw or cancel any claims.

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Election with Traverse

The statutory language upon which restriction practice is based is found in 35 U.S.C. 121:

Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention. [Emphasis added]

Thus, the Director and his agents, have authority to require the restriction of applications to one invention from several, only if more than one invention is claimed in the application. Preemptive restrictions based on material disclosed in the application but not claims, cannot form the basis for a restriction requirement as they are not "two or more independent and distinct inventions ... claimed in one application" 35 U.S.C. 121, *See also* MPEP §802.

Restriction is proper if two or more "independent and distinct" inventions are claimed in one application. "Claims are the definitions of inventions." See MPEP §806.4(e) The Office is respectfully reminded that a non-provisional patent application must comprise at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the U.S. Patent and Trademark Office. (MPEP §601.1(a)) Drawings are, under

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this requirement provided to facilitate "the understanding of the subject matter sought to be patented." 37 CFR 1.81(a), They do not fulfill function of the claim, "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery." [Emphasis Added] 37 CFR 1.75 Thus, by definition, for there to exist a plurality of "independent and distinct" inventions in an application, there must be a plurality of independent and distinct claims in that application. The applicant therefore respectfully submits that, as the invention is defined by the claims, restrictions based on considerations not found in the claims, therefore, not forming part of the definition of the invention, and not evidencing an absence of "commonality of operation, function and effect" (See MPEP §806.4(e)) of the claims, are not proper.

The MPEP clearly articulates instances where restriction requirements are proper in MPEP §803:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

Also provided in this section are guidelines for proper restriction requirements:

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases..

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

The applicant respectfully submits that these guidelines have not been met in relation to the claimed invention, and that no *prima facia* case for either independence or the existence of a burden on the Examiner has been made. Indeed, no reasons are provided in the restriction requirement itself supporting the allegation that there is a plurality of claimed inventions in the present application. Likewise, no reasons are provided to support the inherent allegation that

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there would exist a "serious burden on the examiner". Absent any rationale for the Office's restriction requirement, the applicant respectfully submits that no *prima facia* case for that requirement has been made.

Relating specifically to the issue of Independence and distinctiveness, these terms are defined in the MPEP as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

Accordingly, restriction is proper when there are two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct (MPEP Section 806).

According to MPEP Section 806.03, "where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition."

The Patent Office disfavors double patenting – a restriction requirement that states that there are two separate distinct species would allow patenting of the non-elected separate species, since there is no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case. That determination was made before the

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requirement to restrict was made. Therefore, restriction should not be required if the species claimed are considered clearly unpatentable over each other.

The applicant makes no statement relating to whether the claims of the present application are patentably distinct. The applicant instead, respectfully submits that no *prima facia* rationale has been provided for such a finding, and, as a result, that this requirement is not proper.

Regarding the issue of the search resulting in a "serious burden", the applicant respectfully submits that no *prima facia* case has been made to support such a requirement. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP Section 803, Section 806, and Section 808)

The Office has not demonstrated a serious burden or otherwise shown by appropriate explanation either separate classification, separate status in the art, or a different field of search. Indeed, not even an allegation of any such a burden was made in the Restriction Requirement.

Where the related inventions as claimed [Emphasis added] are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following [Emphasis added]:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The

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indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. *MPEP* § 808.2

No such mandated showing of serious burden has been made. The applicant respectfully draws the Office's attention to the use of the present and past tense verbs used in the relevant MPEP and USC sections. Based upon the choice of language selected by Congress in establishing the practice, and upon the articulation of Office policy and implementation in the MPEP, the Applicant respectfully submits that restriction requirements are not properly made to address prospective burden, but may only be made where such a burden actually exists at the time that the requirement is made. Only in the event that a burden has been created by later claim amendments would it be proper to insist upon such a requirement.

At least for those reasons set forth above, the applicant respectfully requests that the Office reconsider its restriction requirement upon review of the claimed invention, and further requests that the requirement be withdrawn. As required by the Office, Applicant elects with traverse, the invention described in claims 1-31 as drawn to Species II.

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Applicant believes the above remarks and election to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, withdrawal of the restriction requirement and further requests that Examiner contact its attorney by telephone, facsimile, or email for efficient resolution of any remaining issues.

Respectfully submitted,



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